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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,910	12/19/2001	Shigeo Nakagaki	217656US-3TTC CONT	9815

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EXAMINER

TRAN, THUY VAN

ART UNIT PAPER NUMBER

3652

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/020,910

Applicant(s)
Nakagaki et al.

Examiner
Thuy V. Tran

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3652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 8, 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-26 is/are pending in the application.
- 4a) Of the above, claim(s) 5-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/393,688.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 6 6) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Claims 5-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 3.

2. Applicant's election with traverse of Species I, Figure 3 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the election requirement 1) is contrary to MPEP §816; 2) fails to address whether the pending claims recite mutually exclusive characteristics; and 3) a search and examination of the entire application would not place a serious burden on the Examiner. This is not found persuasive because :

1) MPEP § 816 is intended for restriction requirements not election of Species requirements;

2) the pending claims are mutually exclusive because “no claim is generic” as stated in election requirements (Office paper No. 4), page 4, line 6; and

3) MPEP 808.01 indicates that since “claims are directed to independent inventions, restriction is proper pursuant to 35 USC 121, and it is not necessary to show a separate status in the art or separate classification”. Thus, it is felt no “undue burden” test is required for a proper election of species to be required. Assuming arguendo that the existence of undue burden is

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required, each species listed in the requirement for election of species is independent and would require a unique field of search and thus would constitute an undue burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3 and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With regard to equations (1)-(6) on pages 9 & 10 of the specification where the **sum load is assumed to be vertical** (page 9, lines 1-2):

First, it is unclear what applicant meant by "If the connecting structure is a pivot connection, that is, a vertical displacement of the cage guide rail 110 is restricted, but a pivot movement on the junction of the cage guide rail 110 and the bracket 1 is not restricted", found on page 9, lines 9-11. If the only present load is a vertical load and the vertical displacement of the cage guide rail is restricted, then there should be no pivot movement on the junction of the cage guide rail and the bracket. Further, if the vertical displacement of the cage guide rail is restricted,

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then the guide rail ends is rigidly connected to the elevator shaft at at least one of its top and bottom. Thus, there should be no load at the junction of the cage guide rail and the bracket.

Secondly, as described by Applicant on page 9, lines 13-15 that “the connecting structure is a rigid connection, that is, both the vertical displacement of the cage guide rail 110 and the pivot movement are restricted”, and as discussed in the paragraph above with an addition of no pivotal movement, then there should be no bending moment working at the junction of the fastening plate 2 and the shaft wall 4. Further, it is unclear where the bending moment equation $[M_1 = Wh/2]$ for a rigid connection was derived from.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-3 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation “two vertically spaced lines of securing members ..., each line of securing members including at least one securing member”, found in claim 1, lines 9-11, renders the claim indefinite because one securing member cannot form a line.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3 and 26 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. 6,012,554 in view of one of Rousseau 4,593,794, Ericson et al. 4,848,519 and Koeppe, Jr. et al. 5,950,770.

Ito et al '554 disclose an elevator system comprising a driving unit 14, Figure 5, mounted on a guide rail 4 and configure to move a movable unit 1 up and down along the guide rail 4 via a cable 13. The guide rail is installed on the elevator shaft via a plurality of rail support members which are fixed to a wall of the shaft.

Ito et al disclose all the claimed limitations except for how specifically the support members are secured to the wall.

Rousseau '794 discloses an elevator guide rail 30 A, Figure 3, installed on an elevator shaft via a plurality of rail support members (portion perpendicular to shaft wall 32) fixed to a wall 32 of the shaft by means of at least two anchor bolts 84 separated from each other by an interval in the vertical direction, and wherein the anchor bolts comprise upper and lower pairs, each pair of the anchor bolts are separated by an interval in the horizontal direction, and further, the bolts are attached to a plurality of plates 80..

Ericson et al. '519 disclose an elevator guide rail 125, Fig. 1, installed on an elevator shaft via a plurality of rail support members, at least one the rail support member 260 fixed to a wall of the shaft by at least two anchor bolts separated from each other by an interval in the vertical

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direction, and wherein the anchor bolts comprise upper and lower pairs, each pair of the anchor bolts are separated by an interval in the horizontal direction.

Koepppe, Jr. et al. '770 disclose an elevator guide rail 1, Figures 1-5, installed on an elevator shaft via a plurality of rail support members, at least one the rail support member 9 fixed to a wall of the shaft by at least two anchor bolts 12 separated from each other by an interval in the vertical direction, and wherein the anchor bolts comprise upper and lower pairs, each pair of the anchor bolts are separated by an interval in the horizontal direction.

It would have been obvious to one having ordinary skill in the art to at the time the invention was made to secure the rail support members of Ito et al reference with at least two pairs of securing members separated with each other by an interval in both vertical and horizontal direction as disclosed by at least one of the above references, since it was known in the art that mounting the securing members by an interval in the vertical direction would prevent the support members from bending due to the total vertical load of the driving unit and the movable unit, and separating the securing members in the horizontal direction would prevent the support members from twisting due to the lateral movement of the movable unit.

Re the equation for calculating the safety range for the interval of the securing members, it would have been obvious to one having skill in the art at the time the invention was made to separate the securing members in the vertical direction within a safety range, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

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Response to Arguments

9. Applicant's arguments filed May 8, 2002 have been fully considered but they are not persuasive. Applicants had submitted Appendices II (pivot connection or cantilever) and III (rigid connection) for showing how the equation for calculating the safety range for the interval of the securing members was derived from. However, the only existing load in the present application is a vertical load acting on the guide rail, and the guide rail is stationary (fixed), therefore the sum vertical load at the connection between the guide rail and the rail support member is zero. Thus, there is no bending moment.

Further, Applicants argue that none of the applied references shows how to solve the problem that the fastener plates must support the very heavy weight including the guide unit, the movable unit including passengers, and the counterweight. Providing a safe fastener plates to supporting a weight would have been obvious to one ordinary skill in the art, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Conclusion

10. This is a continuation of applicant's earlier Application No. 09/393,688. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier

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application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy v. Tran whose telephone number is (703) 308-2558.

TVT (TVT)

July 29, 2002


DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
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